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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1636

PIPPIG ET AL.

Examiner: Gansheroff, L.

APPLICATION NO: 09/715,249

FILED: NOVEMBER 17, 2000

FOR: SELECTABLE CELL SURFACE MARKER GENES

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Commissioner for Patents  
Washington, D.C. 20231RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In reply to the Office Action dated June 15, 2001, requesting an election of one invention to prosecute in the above-identified patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-3 and 5-29. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse. Applicants respectfully assert that the claims in Groups I-III are closely related in subject matter. As such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of all groups. Hence, Applicants respectfully assert that the claims in all of the groups may be simultaneously searched without imposing a serious burden on the Examiner. Therefore, reconsideration and withdrawal of the restriction requirement, and examination of all pending claims on the merits, are respectfully requested.

At a minimum, the Groups I and II should be examined together. Both groups are considered by the Examiner to be "drawn to methods for identifying genetically modified mammalian cells, for immunoselection of transduced mammalian cells, and for identifying mammalian cells expressing a protein of interest." Moreover, the claims of Groups I and II are classified in the same class and subclass. Group III is drawn to a particular type of modified MuSK-R, which is utilized in the method drawn to Group II.

Search and examination of the entire application can be made without serious burden and the entire application should therefore be examined on the merits. MPEP 803 (Seventh Edition, Rev. I (February 2000)), at page 800-803, right hand column, states as one of the criteria for

restriction that: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits."

In the present case, Applicants respectfully assert that the search of more than one restriction group does not impose a serious burden upon the Examiner, as a search concerning the patentability of the claims of any one group is likely to uncover art of interest to the remaining groups. Additionally, the Examiner states that "in the instant case the different inventions are different methods and a product that is not used in the methods." The Applicants respectfully traverse this statement. More specifically, the search of art related to "methods for identifying genetically modified mammalian cells, for immunoselection of transduced mammalian cells, and for identifying mammalian cells expressing a protein of interest" in Group I should presumably result in information useful to consideration of the method claims drawn to Group II. Also, the "mutated MuSK-R family member" of Group III, is a subset of the "modified MuSK-R family member" used in the method of Group II. Any additional search that would be needed would not be an undue burden on the Examiner. Further, such information would also be useful in determining the patentability of all the additional groups of claims.

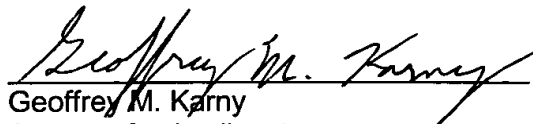
Accordingly, for all of the above reasons and in the interest of efficient advancement of prosecution, it is respectfully requested that the Examiner should reconsider and withdraw the restriction requirement. Furthermore, allowance of all pending claims is respectfully requested.

A Petition for a Five Month Extension of Time is being filed concurrently herewith. It is not believed that further extensions of time are required. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0134 in the name of Novartis Corporation. A duplicate of this paper is enclosed.

Respectfully submitted,

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Date: November 19, 2001

  
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